

REMARKS

Claims 1-15 and 17-18 have been rejected under the judicially created doctrine of obviousness-type double patenting based on the contention that they are unpatentable over claims 1, 3, 5, and 14 of U.S. Patent No. 6,279,184 issued to George (hereinafter the '184 patent) in view of U.S. Patent No. 4,011,611 issued to Lederman (hereinafter the '611 patent). Applicant respectfully traverses the Examiner's rejection of claims 1-15 and 17-18.

As is stated in the Manual of Patent Examining Procedure, "obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent..." See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000). Applicant respectfully submits that, to the best of its knowledge, neither the '184 patent nor the '611 patent, in any way, disclose, teach, or fairly suggest a frameless chair wherein "...at least a portion of the inner liner and the outer liner comprises a material which is capable of elastic deformation" as is expressly required in independent claim 1 of the present invention – as originally filed. As such, Applicant respectfully submits that the claimed subject matter is, indeed, patentably distinct from the subject matter claimed in the commonly owned '184 patent, as well as the '611 patent.

Furthermore, while the analysis employed in an obviousness-type double patenting determination must parallel the guidelines for a 35 U.S.C. 103(a) rejection (*In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 [Fed. Cir. 1991]; *In re Longi*, 759 F.2d 887, 225 USPQ 645 [Fed. Cir. 1985]), Applicant respectfully submits that a prima facie case of obviousness has not been properly established inasmuch as the Examiner has not demonstrated all elements of a prima facie case. To be sure, no suggestion or motivation to combine the reference teachings has been

identified by the Examiner. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that, to the best of its knowledge, neither the '184 patent, nor the '611 patent suggest a desirability of the combination of their respective devices in order to achieve what is expressly claimed by Applicant.

In addition, "to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Contrary to the Examiner's contention, the '184 patent is void of any teaching or suggestion relative to a frameless chair wherein "...at least a portion of the inner liner and the outer liner comprises a material which is capable of elastic deformation" as is expressly required in independent claim 1 of the present application – as originally filed. Therefore, Applicant respectfully submits that the basis for rejection of independent claim 1 under the judicially created doctrine of obviousness-type double patenting has been overcome – unless the Examiner can specifically point out where in the '184 patent it is contemplated to use a material which is capable of elastic deformation for the inner and outer liners. Accordingly, reconsideration and withdrawal of the double patenting rejection based upon the above-identified references are respectfully requested. Applicant further respectfully submits that inasmuch as claims 2-15 and 17-18 ultimately depend from claim 1, the Examiner's rejection of the same should be rendered moot.

Claims 1-8, 10-15, and 17-18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,148,564 issued to Reder (hereinafter the '564 patent) in view of the '611 patent. Applicant respectfully traverses the Examiner's rejection of claims 1-8, 10-15,

and 17-18.

First, Applicant respectfully submits that a prima facie case of obviousness has not been established inasmuch as the Examiner has not demonstrated all elements of a prima facie case. First, no suggestion or motivation to combine the reference teachings is shown. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Applicant respectfully submits that neither the '564 patent nor the '611 patent suggest a desirability of the combination of their respective devices in order to achieve what is claimed by Applicant.

In addition, "to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). However, neither the '564 patent nor the '611 patent teach or suggest that "...at least a portion of the inner liner and the outer liner comprises a material which is capable of elastic deformation" as is expressly claimed in Applicant's independent claim 1. With regard to the Examiner's contention that the '564 patent discloses such a limitation in column 3, lines 36-42, Applicant respectfully submits that the Examiner's position is incorrect. Column 3, lines 36-42 of the '564 patent disclose a "flexible nature of the outer cover 16 and the resilient pliable nature of the inner body 12, [wherein] the pillow construction may be manipulated to remove the inner body (and its flexible inner cover 14) from the outer cover through the entrance/exit...[or] to put it back inside the outer cover." Applicant respectfully submits that the words "flexible" and "pliable," in no way, disclose or suggest the use of "a material which is capable of elastic deformation." As is well known in the art, as is commonly known by the general public, and as is disclosed, among other places, on pages 8 and 9 of the specification, the term elastic, when used

in association with a material, requires that a material be capable of stretching, which limitation is not, in any way, taught or suggested by either one of the terms "flexible" or "pliable." Therefore, Applicant respectfully submits that the Examiner's opinion of obviousness is deficient and that, as endorsed by the Federal Circuit in *In re Oetiker*, because "examination at the initial stage [did] not produce a prima facie case of unpatentability,...Applicant is entitled to grant of the patent." *Id.*, 24 USPQ 2d at 1444.

As such, Applicant respectfully submits that the basis for rejection of independent claim 1 under 35 U.S.C. §103(a) has been overcome. Accordingly, reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection based upon the above-identified references are respectfully requested. Applicant further respectfully submits that inasmuch as claims 2-8, 10-15, and 17-18 ultimately depend from claim 1, the Examiner's rejection of the same should be rendered moot.

Claim 9 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the '564 patent in view of the '611 patent, and further in view of U.S. Patent No. 4,780,921 issued to Lahn et al. (hereinafter the '921 patent). Applicant respectfully traverses the Examiner's rejection of claim 9.

First, Applicant respectfully submits that a prima facie case of obviousness has not been established inasmuch as the Examiner has not demonstrated all elements of a prima facie case. First, no suggestion or motivation to combine the reference teachings is shown. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Applicant respectfully submits that neither the '564 patent, the '611 patent, nor the '921 patent suggest a desirability of the combination of their respective devices in order to achieve what is claimed by Applicant.

In addition, "to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). However, neither the '564 patent, the '611 patent, nor the '921 patent teach or suggest that "...at least a portion of the inner liner and the outer liner comprises a material which is capable of elastic deformation" as is expressly claimed in Applicant's independent claim 1, from which Applicant's claim 9 depends. Therefore, unless the Examiner can specifically point out where in the '564 patent, the '611 patent, and the '921 patent it is contemplated to use a material which is capable of elastic deformation for the inner and outer liners, Applicant respectfully submits that the Examiner's opinion of obviousness is deficient and that, as endorsed by the Federal Circuit in *In re Oetiker*, because "examination at the initial stage [did] not produce a prima facie case of unpatentability,...Applicant is entitled to grant of the patent." *Id.*, 24 USPQ 2d at 1444.

As such, Applicant respectfully submits that the basis for rejection of claim 9 under 35 U.S.C. §103(a) has been overcome. Accordingly, reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection based upon the above-identified references are respectfully requested.

Claim 16 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the '564 patent in view of the '611 patent, and further in view of U.S. Patent No. 5,375,278 issued to VanWinkle (hereinafter the '278 patent). Applicant respectfully traverses the Examiner's rejection of claim 16.

First, Applicant respectfully submits that a prima facie case of obviousness has not been established inasmuch as the Examiner has not demonstrated all elements of a prima facie case. First, no suggestion or motivation to combine the reference teachings is shown. "The mere fact that references can be combined or modified does not render the resultant combination obvious

unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Applicant respectfully submits that neither the '564 patent, the '611 patent, nor the '278 patent suggest a desirability of the combination of their respective devices in order to achieve what is claimed by Applicant.

In addition, "to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). However, neither the '564 patent, the '611 patent, nor the '278 patent teach or suggest that "...at least a portion of the inner liner and the outer liner comprises a material which is capable of elastic deformation" as is expressly claimed in Applicant's independent claim 1, from which Applicant's claim 16 depends. Therefore, unless the Examiner can specifically point out where in the '564 patent, the '611 patent, and the '278 patent it is contemplated to use a material which is capable of elastic deformation for the inner and outer liners, Applicant respectfully submits that the Examiner's opinion of obviousness is deficient and that, as endorsed by the Federal Circuit in *In re Oetiker*, because "examination at the initial stage [did] not produce a prima facie case of unpatentability,...Applicant is entitled to grant of the patent." *Id.*, 24 USPQ 2d at 1444.

As such, Applicant respectfully submits that the basis for rejection of claim 16 under 35 U.S.C. §103(a) has been overcome. Accordingly, reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection based upon the above-identified references are respectfully requested.

Claims 1-15 and 17-18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the '184 patent in view of the '611 patent. Applicant respectfully traverses the Examiner's rejection of claim 1-15 and 17-18.

First, Applicant respectfully submits that a prima facie case of obviousness has not been established inasmuch as the Examiner has not demonstrated all elements of a prima facie case. First, no suggestion or motivation to combine the reference teachings is shown. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Applicant respectfully submits that neither the '184 patent nor the '611 patent suggest a desirability of the combination of their respective devices in order to achieve what is claimed by Applicant.

In addition, "to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). However, neither the '184 patent nor the '611 patent teach or suggest that "...at least a portion of the inner liner and the outer liner comprises a material which is capable of elastic deformation" as is expressly claimed in Applicant's independent claim 1. Therefore, unless the Examiner can specifically point out where in the '184 patent and the '611 patent it is contemplated to use a material which is capable of elastic deformation for the inner and outer liners, Applicant respectfully submits that the Examiner's opinion of obviousness is deficient and that, as endorsed by the Federal Circuit in *In re Oetiker*, because "examination at the initial stage [did] not produce a prima facie case of unpatentability,...Applicant is entitled to grant of the patent." *Id.*, 24 USPQ 2d at 1444.

As such, Applicant respectfully submits that the basis for rejection of independent claim 1 under 35 U.S.C. §103(a) has been overcome. Accordingly, reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection based upon the above-identified references are respectfully requested. Applicant further respectfully submits that inasmuch as claims 2-15 and 17-18

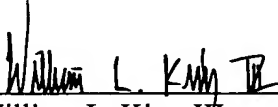
ultimately depend from claim 1, the Examiner's rejection of the same should be rendered moot.

In light of the foregoing, Applicant respectfully submits that the application is in *prima facie* condition for allowance at the present time. Accordingly, Applicant respectfully requests reconsideration of the present application and passage toward issuance thereof.

Respectfully submitted,

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